## REMARKS

**Claim Rejections 35 U.S.C. § 103**

The Examiner has rejected pending Claims 1, 3, 9 and 11 under 35 USC §103(a) as being unpatentable over Kamiya et al. (USPN 5,192,309) in view of Kensey et al. (USPN 5,676,689.) The Examiner contends that the Kamiya reference discloses a locator device having an elongate member with a distal opening "(portion of 27 adjacent lumen 24)," a proximal opening (through which the guidewire is inserted) and an expandable occlusion member (21) in contact with the lumen of the elongate member and located distally of the distal opening of the elongate member. The Examiner acknowledges that Kamiya et al. fails to disclose the use of a bioabsorbable material, but cites the Kensey reference to supply this missing teaching. With regards to the Kamiya reference, the Examiner states "the elongate member and occlusion member are capable of performing the functions as claimed."

In Applicant's response to the Final Office Action mailed April 21, 2009, Applicant argued that the "distal opening" disclosed by Kamiya was in fact the side arm of a catheter, and therefore, did not meet the claim limitation of "adapted to extend into a blood vessel." However, the Examiner maintains that the phrasing "adapted to" does not "constitute a limitation in any patentable sense." Although Applicant disagrees and contends that one of skill in the art would recognize that being adapted to extend into a blood vessel imparts certain structural characteristics, which are clearly not shared by the side arm of a catheter, Applicant has amended the claims to clarify this distinction over the prior art. Specifically, Claim 1 now requires that the elongated member have a distal portion with a substantially uniform outer diameter, wherein the distal opening is located within the distal portion. The other independent claims, Claims 5 and 9, have also been amended with equivalent limitations. This aspect of the invention is clearly shown in Figs. 1, 2 and 11 of the application as filed.

In contrast, one of skill in the art would immediately recognize that element 27 of the Kamiya reference is a conventional catheter side arm that allows fluids to be introduced to or withdrawn from the lumen of the catheter while the distal end is positioned within the patient. As such, element 27 is designed to remain outside the body of the patient and this portion of the elongated member of Kamiya does not have "a substantially uniform outer diameter." Indeed,

the side arm 27 must provide an engagement with other instruments so that fluid can be introduced to the device. For example, the corresponding structure 15 from Fig. 26 is described as follows: "physiological saline at a temperature of 45°C is injected to the catheter 12 through the inlet 15, and the flange is recovered to the original shape and thus the closing plug is tightly fixed to the defect to close it." Thus, it is apparent that element 15, and likewise element 27, function as catheter side arms and correspondingly, Kamiya's elongated member does not have a substantially uniform outer diameter at the distal opening.

As discussed previously, the secondary Kensey reference is cited only for its suggestion of using bioabsorbable materials, so it does not compensate for the deficiency of Kamiya. Accordingly, the combination of Kamiya et al. and Kensey et al. does not suggest the invention as claimed. Therefore, applicant respectfully requests that Examiner reconsider and withdraw the § 103 rejection of pending Claims 1, 3, 9 and 11.

**Rejoinder of Claims 5 and 7**

As discussed in previously, Applicant requests that method Claims 5 and 7 be rejoined, as they have been amended to share all the structural limitations of the product claims discussed above. Additionally, Applicant respectfully submits that the cited Kamiya reference does not disclose or suggest the method as claimed. In the discussion above, Applicant has pointed out that element 27, which the Examiner has determined corresponds to the claimed first opening, is in fact a catheter side arm that clearly is intended to remain outside the blood vessel. Accordingly, there is no teaching or suggestion to advance the elongate member until the first opening is located within the lumen of the blood vessel as required by the claims. Further, since the secondary reference Kensey et al. does not compensate for this deficiency, Applicant respectfully submits that Claims 5 and 7 are patentable over the art of record.

**Conclusion**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The Examiner is encouraged to call the undersigned collect at (415) 705-6377 if there are any outstanding issues or questions which can be resolved to allow this application to be passed to issue.

Respectfully submitted,

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